

**REMARKS**

Claims 1-6 have been examined. With this amendment, Applicants add claim 7. Claims 1-7 are all the claims pending in the application.

**I. Formalities**

Applicants thank the Examiner for initialing and returning a copy of the form PTO-1449 submitted with the Information Disclosure filed on January 28, 2004.

**II. Claim Rejections - 35 U.S.C. § 112**

The Examiner has rejected claim 6 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner contends that claim 6 redefines the intermediate layer of claim 5.

Applicants submit that the modifications to claim 6 obviate the rejection.

**III. Claim Rejections - 35 USC § 103**

The Examiner has rejected claims 1-3 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe *et al.* (US 2001/0016522) ["Watanabe '522"]. For at least the following reasons, Applicants traverse the rejection.

Applicants are submitting herewith an unsigned declaration by Mr. Watanabe, one of the inventors, in support of the arguments given below. A signed copy of the declaration will follow. Applicants respectfully request that the Examiner contact Applicants' representative if the signed declaration has not been submitted by the time the Examiner is ready to review Applicants' response.

The present invention pertains to a golf ball comprising a core, an intermediate layer enclosing the core to form a sphere, and a cover enclosing the intermediate layer. Applicants have found that when the Shore D hardness relationship between the intermediate layer and the cover, the initial velocity relationship between the core and the sphere, the Deflection amount relationship between the core and the sphere, and the total thickness of the intermediate layer and the cover are consistent with the parameters as set forth in claim 1, the golf ball has a good rebound profile, feel and durability and is well suited for players whose golf club swings have a low head speed. The present invention as set forth in claim 1 is predicated on this finding.

In particular, Applicants submit that an important element as set forth in claim 1 is claimed element (2),  $(\text{initial velocity of the sphere}) - (\text{initial velocity of the core}) > 0$ .

Watanabe '522 is silent with respect to claimed element (2), and, in fact, Example 1 of Watanabe '522 arguably teaches away from claimed element (2) because the golf ball of Example 1 of Watanabe '522 is inferior to the golf ball of present invention (see Mr. Watanabe's Declaration comparing Example 1 of Watanabe '522 with Examples 1-3 of the present specification, especially, flight performance of total (m) as shown in Table 3 of Mr. Watanabe's Declaration and Table 3 of the present Specification, respectively). Accordingly, as shown from Mr. Watanabe's Declaration and the present specification, there is a patentable difference between the requirements of claim 1 and the disclosure in Watanabe '522.

Applicants submit that Examples 2-4 of Watanabe '522 would produce results similar to those of Example 1 because Examples 1-4 of Watanabe '522 are common to one another in having the features of Watanabe '522's invention.

Thus, Watanabe '522 fails to disclose or suggest at least claimed element (2) as set forth in claim 1 since Watanabe '522 teaches away from the present invention as set forth in claim 1 and the effects thereof for at least the reasons given above. Accordingly, claim 1 is patentable (unobvious) over Watanabe '522.

Because claims 2, 3 and 5 depend on claim 1, Applicants submit that these claims are patentable at least by virtue of their dependency.

#### **IV. New Claims**

With this amendment, Applicants add claim 7. Applicants submit that claim 7 is patentable at least by virtue of its dependency, as well as the features set forth therein.

#### **V. Allowable Subject Matter**

Applicants thank the Examiner for finding allowable subject matter in claim 4 and for indicating that claim 4 would be allowable if rewritten in independent form.

Applicants hold rewriting claim 4 on abeyance until the subject matter of claim 1 is resolved.

#### **VI. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111  
U.S. Serial No. 10/765,088

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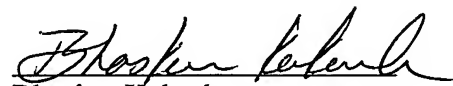
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**23373**

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